

REMARKS

Claims 1-3, 5-23, and 25-45 are pending in the present Application. Claims 1-3, 5-11, 13-17, 18-23, 25-31, 33-37, and 39-45 currently stand rejected. Claims 12, 18, 32, and 38 are objected to, but would be allowable if rewritten in independent form including all limitations of the base claim and any intervening claims. Accordingly, claims 1, 11-12, 18, 21, 31-32, 38, and 41-42 are amended herein. Reconsideration of the Application in view of the foregoing amendments and the following remarks is respectfully requested.

35 U.S.C. § 103

On page 4 of the Office Action, the Examiner rejects claims 1-3, 5-9, 21-23, 25-29, and 42-45 under 35 U.S.C. § 103 as being unpatentable over U.S. Patent Application No. 2003/0037158 to Yano et al. (hereafter Yano) in view of U.S. Patent Application No. 2001/0010059 to Burman et al. (hereafter Burman), and further in view of U.S. Patent No. 6,065,059 to Shieh et al. (hereafter Shieh). The Applicants respectfully traverse these rejections for at least the following reasons.

Applicants maintain that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a) which requires that three basic criteria must be met, as set forth in M.P.E.P. §2142:

"First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there

must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations" (emphasis added).

The initial burden is therefore on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Regarding the Examiner's rejection of independent claims 1, 21, and 41-42, Applicants respond to the Examiner's §103 rejections as if applied to amended independent claims 1, 21, and 41-42 which are now amended to recite "*said source device converting a bandwidth value from said communication path into a transfer speed value for determining said transfer duration,*" which are limitations that are not taught or suggested either by the cited references, or by the Examiner's citations thereto. Applicants submit that the foregoing amendments are supported by claims 12 and 32, as originally filed, and therefore do not necessitate a new search.

The Examiner cites a primary reference to Yano in support of the foregoing rejections. Yano teaches a generic "data communication" method. However, Yano only teaches adjusting a "*transfer rate*" to optimize data transfers from a source to a destination based upon the current volume of transfer data that is still in transit (see paragraph 007). However, Applicants submit that Yano nowhere discloses "*said system user manipulating said transfer data using said transfer options to change said transfer duration . . . ,*" as claimed by Applicants (emphasis added). Applicant further submits that Yano fails to disclose "*said transfer manager being integral to said source device,*" as claimed by Applicants.

The Examiner concedes that “Yano fails to teach determining a transfer duration” Applicants concur. The Examiner then points to Burman to purportedly remedy the foregoing defects. Burman teaches a “server” of a computer network that pushes information to a network device (destination) at the request of the network device (see Abstract). The data flow of Burman is therefore from server to device and is initiated by the destination device. In contrast, Applicants claim a source “digital camera device” that utilizes an integral “transfer manager” to initiate and control a transfer of image data to a “destination device” that may be implemented as an image station website.

Applicants submit that their claimed “digital camera device” is not analogous to the “server” taught by Burman. Applicants also maintain that Burman teaches a data flow that is directly opposite from the data flow from camera to website as disclosed and claimed by Applicants. In addition, Applicants claim a data transfer that is initiated and controlled by the source device (digital camera). Burman teaches a “pull” operation, while Applicants teach a “push” operation. Applicants therefore submit that Burman teaches away from their claimed invention. A prior art reference which teaches away from the presently claimed invention is “strong evidence of nonobviousness.” In re Hedges, 783 F.2d 1038, 228 U.S.P.Q. 2d 685 (Fed. Cir. 1987).

In addition, the Examiner points to Shieh to further support the rejection of claims 1-3, 5-9, 21-23, 25-29, and 42-45. Shieh teaches providing data from a server to a requesting client, subject to certain “established limits” (see column 2, lines 6-13). Therefore, as in the Burman reference, Shieh teaches a pull

operation, while Applicants disclose a push operation. In particular, Applicants claim a data transfer that is initiated and controlled by the source device (digital camera).

Applicants therefore submit that Shieh also teaches away from their claimed invention. As stated previously, a prior art reference which teaches away from the presently claimed invention is “strong evidence of nonobviousness.” In re Hedges, 783 F.2d 1038, 228 U.S.P.Q. 2d 685 (Fed. Cir. 1987). Applicants respectfully submit that since Burman and Shieh both teach away from Applicants’ invention, as discussed above, the combination of Yano, Burman, and Shieh could not possibly result in Applicants’ invention. Furthermore, as discussed above, Applicants submit that none of the cited references disclose the limitations of “said system user manipulating said transfer data using said transfer options to change said transfer duration . . . ,” as claimed by Applicants.

Regarding the Examiner’s rejection of dependent claims 2-3, 5-9, 22-23, 25-29, and 44-45, for at least the reasons that these claims are dependent from respective independent claims whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of the respective independent claims, are also not identically taught or suggested. Applicants therefore respectfully request reconsideration and allowance of dependent claims 2-3, 5-9, 22-23, 25-29, and 44-45.

With further regard to claim 43, “means-plus-function” language is utilized to recite elements and functionality similar to those recited in claims 1 and 21

which are discussed above. Applicants therefore incorporate those remarks by reference with regard to claim 43. In addition, the Courts have frequently held that “means-plus-function” language, such as that of claim 43, should be construed in light of the Specification. More specifically, means-plus-function claim elements should be *construed to cover the corresponding structure, material or acts described in the specification*, and equivalents thereof. Applicants respectfully submit that, in light of the substantial differences between the teachings of the cited references and Applicants’ invention as disclosed in the Specification, claim 43 is therefore not anticipated or made obvious.

With further regard to the rejections of claims 5 and 25, the Examiner cites page 4, paragraph 0035, of Burman in support of these rejections. Applicants respectfully traverse. In particular, Applicants submit that page 4, paragraph 0035, of Burman nowhere discloses a “data size value”, an “option manager,” or a “data editor,” as claimed by Applicants. For at least the foregoing reasons, Applicants submit that the rejections under 35 U.S.C. §103(a) are improper.

With further regard to the rejections of claims 7 and 27, the Examiner cites Burman in support of these rejections. In particular, the Examiner vaguely states “see page 9” for support. Applicants respectfully traverse. In particular, Applicants submit that nowhere on “page 9” does Burman disclose any sort of “user interface” that displays the various specific fields that are explicitly claimed by Applicants. For at least the foregoing reasons, Applicants submit that the rejections under 35 U.S.C. §103(a) are improper.

With further regard to the rejections of claims 8 and 28, the Examiner cites Burman in support of these rejections. In particular, the Examiner vaguely states “see page 4” for support. Applicants respectfully traverse. In particular, Applicants submit that nowhere on “page 4” does Burman disclose any type of transfer option fields that include “*a perform transfer option, a cancel transfer option, a postpone transfer option, a change transfer-mode option, and an alter transfer-data option, said alter transfer-data option including a reduce data-size option, an increase data-size option, a crop image option, a reduce image-resolution option, an increase image-resolution option, and a compress data option,*” as explicitly claimed by Applicants.

Applicants further submit that none of the cited references disclose the utilization of transfer option fields that are implemented in any manner that is similar to those techniques disclosed and claimed by Applicants. For at least the foregoing reasons, Applicants submit that the rejections under 35 U.S.C. §103(a) are improper.

With further regard to the rejection of claim 44, the Examiner cites page 2, paragraph 0011, of Yano in support of these rejections. However, there appears to be no such paragraph numbered as paragraph 0011 to be found on page 2 of Yano. Applicants therefore submit that they are unable to adequately respond to the Examiner’s comments, and therefore the rejections under 35 U.S.C. §103(a) are improper.

With further regard to the rejection of claim 45, the Examiner cites page 4, paragraph 35 of Burman in support of these rejections. Applicants respectfully

traverse. In particular, Applicants submit that nowhere on page 4, paragraph 35 does Burman disclose a “*system user repeatedly utilizing said user interface . . . for each instance of said data transfer operation,*” as explicitly claimed by Applicants. For at least the foregoing reasons, Applicants submit that the rejections under 35 U.S.C. §103(a) are improper.

For at least the foregoing reasons, the Applicants submit that claims 1-3, 5-9, 21-23, 25-29, and 42-45 are not unpatentable under 35 U.S.C. § 103 over the cited references. The Applicants therefore respectfully request reconsideration and withdrawal of the rejections of claims 1-3, 5-9, 21-23, 25-29, and 42-45 under 35 U.S.C. § 103.

On page 11 of the Office Action, the Examiner rejects claims 10-11 and 30-31 under 35 U.S.C. § 103 as being unpatentable over Yano, Burman and Shieh, and further in view of U.S. Patent No. 5,774,583 to Sasaki et al. (hereafter Sasaki). The Applicants respectfully traverse these rejections for at least the following reasons.

Regarding the Examiner’s rejection of dependent claims 10-11 and 30-31, for at least the reasons that these claims are directly or indirectly dependent from respective independent claims whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of the respective independent claims, are also not identically taught or suggested. Applicants therefore respectfully request

reconsideration and allowance of dependent claims 10-11 and 30-31 so that these claims may issue in a timely manner.

Furthermore, the Court of Appeals for the Federal Circuit has held that “obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination.” In re Geiger, 815 F.2d 686, 688, 2 U.S.P.Q.2d 1276, 1278 (Fed. Cir. 1987). As discussed above, Burman and Shieh teach away from Applicants’ claimed invention. Applicants therefore submit that the cited references could not suggest a combination that would result in Applicants’ invention, and therefore the obviousness rejections under 35 U.S.C §103 are improper.

For at least the foregoing reasons, the Applicants submit that claims 10-11 and 30-31 are not unpatentable under 35 U.S.C. § 103 over the cited references, and that the rejections under 35 U.S.C. § 103 are thus improper. The Applicants therefore respectfully request reconsideration and withdrawal of the rejections of claims 10-11 and 30-31 under 35 U.S.C. § 103.

On page 13 of the Office Action, the Examiner rejects claims 13-17, 19, 33-37, and 39 under 35 U.S.C. § 103 as being unpatentable over Yano, Burman, Shieh, and Sasaki, and further in view of JP Patent Application No. 09-060776 to Norio et al. (hereafter Norio). The Applicant respectfully traverses these rejections for at least the following reasons.

Applicant maintains that the Examiner has failed to make a *prima*

facie case of obviousness under 35 U.S.C. § 103(a). As discussed above, for a valid *prima facie* case of obviousness under 35 U.S.C. § 103(a), the prior art references when combined must teach or suggest all the claim limitations." The initial burden is on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Applicants respectfully traverse the Examiner's assertion that modification of the device of Yano according to the teachings of Burman, Shieh, Sasaki and Norio would produce the claimed invention. Applicants submit that cited references fail to teach a substantial number of the claimed elements of the present invention. Furthermore, Applicants also submit that neither Yano, Burman, Shieh, Sasaki, nor Norio contain teachings for combining the cited references to produce the Applicants' claimed invention. The Applicants therefore respectfully submit that the obviousness rejections under 35 U.S.C §103 are improper.

Further regarding the Examiner's rejection of dependent claims 13-17, 19, 33-37, and 39, for at least the reasons that these claims are directly or indirectly dependent from respective independent claims whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of the respective independent claims, are also not identically taught or suggested. For at least the foregoing reasons, the Applicants submit that claims 13-17, 19, 33-37, and 39 are not unpatentable under 35 U.S.C. § 103 over the cited references, and that the rejections under 35 U.S.C. § 103 are thus improper. The Applicants therefore

respectfully request reconsideration and withdrawal of the rejections of claims 13-17, 19, 33-37, and 39 under 35 U.S.C. § 103.

On page 19 of the Office Action, the Examiner rejects claims 20 and 40 under 35 U.S.C. § 103 as being unpatentable over Yano, Burman, Shieh, and further in view of U.S. Patent No. 6,078,919 to Ginzburg et al. (hereafter Ginzburg). The Applicant respectfully traverses these rejections for at least the following reasons.

Regarding the Examiner's rejection of dependent claims 20 and 40, for at least the reasons that these claims are dependent from respective independent claims whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of the respective independent claims, are also not identically taught or suggested. Applicants therefore respectfully request reconsideration and allowance of dependent claims 20 and 40 so that these claims may issue in a timely manner.

With further regard to the rejections of claims 20 and 40, the Examiner cites column 1, line 56 to column 2, line 16, of Ginzburg in support of these rejections. Applicants respectfully traverse. Column 1, line 56 to column 2, line 16, of Ginzburg teaches using "network parameters" to determine an optimal size of an internal buffer" (see column 2, lines 8-9). Applicants submit that column 1, line 56 to column 2, line 16, of Ginzburg nowhere discloses "*specifying an optimal value for said transfer duration,*" or "*automatically altering said transfer data using*

available transfer options” to attain the claimed optimal value, as recited by Applicants. For at least the foregoing reasons, Applicants submit that the rejections under 35 U.S.C. §103(a) are improper.

Also with regard to claims 20 and 40, the Examiner states that “[i]t would have been obvious to one in the ordinary skill in the art . . . to incorporate wherein said system user specifies an optimal value for said transfer duration. . . to deliver data over a wide variety of different types of network”

Applicants respectfully submit that a *general restatement of the advantages disclosed by the Applicants* deriving from implementation of the present invention cannot act as the required teaching or suggestion to combine cited references for a proper rejection under 35 U.S.C. § 103. Courts have repeatedly held that “it is impermissible . . . simply to engage in *hindsight reconstruction* of the claimed invention, using the Applicants’ structure as a template and selecting elements from references to fill in the gaps.” In re Gorman, 18 USPQ 1885, 1888 (CAFC 1991).

For at least the foregoing reasons, the Applicants submit that claims 20 and 40 are not unpatentable under 35 U.S.C. § 103 over the cited references, and that the rejections under 35 U.S.C. § 103 are thus improper. The Applicants therefore respectfully request reconsideration and withdrawal of the rejections of claims 20 and 40 under 35 U.S.C. § 103.

On page 20 of the Office Action, the Examiner rejects claim 41 under 35 U.S.C. § 103 as being unpatentable over Yano, Burman, Shieh, and further in

view of U.S. Patent No. 6,512,778 to Jones et al. (hereafter Jones). The Applicant respectfully traverses these rejections for at least the following reasons.

Applicant maintains that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a). As discussed above, for a valid *prima facie* case of obviousness under 35 U.S.C. § 103(a), the prior art references when combined must teach or suggest all the claim limitations." The initial burden is on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Regarding the Examiner's rejection of dependent claim 41, for at least the reasons that this claim is directly or indirectly dependent from a respective independent claim whose limitations are not identically taught or suggested, the limitations of this dependent claim, when viewed through or in combination with the limitations of the respective independent claim, are also not identically taught or suggested. Applicants therefore respectfully request reconsideration and allowance of dependent claim 41 so that this claim may issue in a timely manner.

In addition, the Examiner concedes that Yano, Burman, and Shieh "fails to teach the step of entering a hint mode" Applicants concur. The Examiner then points to Jones to purportedly remedy these defects. As discussed above in conjunction with the rejections of claims 1 and 21, both Burman and Shieh teach away from Applicants' invention. A prior art reference which teaches away from the presently claimed invention is "strong evidence of nonobviousness." In re Hedges, 783 F.2d 1038, 228 U.S.P.Q. 2d 685 (Fed. Cir. 1987). Applicants submit that since Burman and Shieh teach away from Applicants' invention, the

combination of Jones and the other cited references would not result in Applicants' invention.

For at least the foregoing reasons, the Applicants submit that claim 41 is not unpatentable under 35 U.S.C. § 103 over the cited references, and that the rejections under 35 U.S.C. § 103 are thus improper. The Applicants therefore respectfully request reconsideration and withdrawal of the rejections of claim 41 under 35 U.S.C. § 103.

Allowable Subject Matter

On page 22 of the Office Action, the Examiner indicates that claims 12, 18, 32, and 38 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicants therefore amend claims 12, 18, 32, and 38 in independent form including all of the limitations of the base claim and any intervening claims, to thereby place claims 12, 18, 32, and 38 in condition for immediate allowance.

Summary

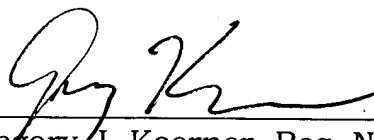
Applicants submit that the foregoing amendments and remarks overcome the Examiner's rejections under 35 U.S.C. §103. Because the cited references, or the Examiner's citations thereto, do not teach or suggest the claimed invention, and in light of the differences between the claimed invention and the cited prior art, Applicants therefore submit that the claimed invention is patentable over the cited art, and respectfully request the Examiner to allow claims 1-3, 5-23, and 25-45, so that the present Application may issue in a timely manner. If there are any questions concerning this amendment, the Examiner is invited to contact the Applicants' undersigned representative at the number provided below.

Respectfully submitted,

Date: _____

1/23/07

By: _____



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